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Paper No. 16

CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re European Telecommunications Standards Institute

Serial No. 75/591,159

Mark B. Harrison of Venable, Baetjer, Howard and  
Civiletti for European Telecommunications Standards  
Institute.

Tonja M. Gaskins, Trademark Examining Attorney, Law  
Office 112 (Janice O'Lear, Managing Attorney).

Before Hairston, Walters and Drost, Administrative  
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

European Telecommunications Standards Institute has  
filed an application to register on the Principal  
Register the mark 3GPP for a variety of goods and  
services in International Classes 9, 16, 35, 38 and 42.<sup>1</sup>

<sup>1</sup> Serial No. 75/591,159, filed November 16, 1998, based on an allegation  
of a bona fide intention to use the mark in commerce.

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The Examining Attorney refused registration on the ground that the identification of goods and services was indefinite and required amendment. Applicant filed a response amending the existing identification of goods and services and adding services in International Classes 39 and 40. The Examining Attorney continued the refusal with respect to the identified goods and services in International Classes 9 and 39. Applicant declined to further amend its identification of goods and services and the examining attorney made the refusal final.

Applicant filed a notice of appeal, a request for reconsideration and a request to divide the application. Pursuant to applicant's request, the goods and services in International Classes 16, 35, 38, 40 and 42 were divided out of this application (the "parent" application) and a "child" application was created, Serial No. 75/981,059. Application Serial No. 75/591,159, the parent application, retained goods and services in International Classes 9 and 39. Upon reconsideration, the examining attorney accepted the further amendment to the identification of services in International Class 39.

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However, the examining attorney continued the final refusal to register in application Serial No. 75/591,159, under Section 1 of the Trademark Act, 15 U.S.C. 1051, on the ground that applicant's identification of goods in International Class 9 is indefinite.<sup>2</sup> Both applicant and the examining attorney have filed briefs, but an oral hearing was not requested.

The identification of goods in International Class 9 (as amended in applicant's request for reconsideration) is as follows:

Telecommunication apparatus and instruments, namely, cellular mobile systems, namely transmitters, receivers, handsets, playstations, antennas; network terminals and telecommunications and networking infrastructure equipment, namely, computer hardware and software for use by telecommunications carriers and network service providers to deliver data and voice communication services; microprocessors; electrical apparatus and instruments, namely, radio and telecommunications transmitters and electrical power supplies therefor; optical apparatus and instruments, namely, infrared signal transmitters and lasers; measuring apparatus and instruments, namely, receivers for receiving, analyzing and measuring radio frequency signals and power; signaling apparatus and instruments, namely, radio frequency signaling devices,

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<sup>2</sup> The application includes services in International Class 39 that are not subject to refusal and, thus, are not considered in this appeal. However, should applicant not ultimately prevail in its appeal, the examining attorney's refusal pertains to the application in its entirety. Similarly, applicant may not seek a remand after this Board's decision for consideration of a further amendment to its identification of goods, as the Board has no authority to allow such action. Applicant's only recourse would be to file a new application.

namely radio frequency transmitters and receivers; audio and visual alerting devices, namely telephone alerting devices, namely electronic horns, speakers, strobe lights, and ringers, loop extenders, ring generators, modular cords, and ring repeaters; teaching apparatus and instruments, namely, laboratory and scientific equipment; computer software, namely, software used for the operation of cellular mobile telecommunication and data communication systems, and database management; computer hardware and peripheral equipment therefor; multimedia software recorded on CD-ROM used for the operation of cellular mobile telecommunication and data communication systems; electronic and magnetic storage media, namely, CD-ROMs, video discs, optical drives, magnetic disc drives, magnetic tapes and optical data carriers; electronic memory integrated circuit chips; voice coders and decoders; tapes, discs, wires and cards all encoded with computer programs and/or data used for the operation of cellular mobile telecommunication and data communication systems, and database management; magnetically encoded pre-paid cards, smart cards and SIM (Subscriber Identity Module) cards; video conferencing equipment, namely teleconferencing equipment; optical character recognition apparatus; communications equipment, namely, cellular mobile telephone stations/handsets, radio receivers and transmitters, audio and video broadcasting apparatus namely, digital and analogue signal transmitters, receivers and converters, radio, television and telephone transmitters, receivers and servers; fixed multi-channel communication apparatus; modems, vehicular communication apparatus, namely mobile phones, vehicular transceivers, and car kits for the adaptation of portable communication apparatus and instruments for vehicular use; facsimile machines, data communication apparatus, namely transmitters, receivers, transceivers and microprocessors; voice frequency transmitters, telephone transmitters and receivers, and telephone terminals for the transmission, storage and reproductions of sound, text, images and data; and parts thereof.

The allegedly indefinite portions of the identification of goods, and the examining attorney's requirements<sup>3</sup> in connection therewith, are detailed below:

1. Current identification: *"telecommunication apparatus and instruments, namely, cellular mobile systems, namely transmitters, receivers, handsets, playstations, antennas"*

examining attorney's objection: Playstation is a registered trademark and must be deleted.

2. Current identification: *"network terminals"*

examining attorney's objection: applicant must specify the type of network terminals, e.g., computer network terminals.

3. Current identification: *"telecommunications and networking infrastructure equipment, namely, computer hardware and software for use by telecommunications carriers and network service providers to deliver data and voice communication services"*

examining attorney's objection: applicant must specify the type of "networking infrastructure," e.g., computer networking infrastructure.

4. Current identification: *"microprocessors; electrical apparatus and instruments, namely, radio and telecommunications transmitters and electrical power supplies therefor"*

examining attorney's objection: applicant must specify the type of "telecommunications transmitters," e.g., telephone telecommunications transmitters.

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<sup>3</sup> In each allegation by the examining attorney, the required amendment is assumed to include the requirement that the "common commercial names" of the goods be used.

5. Current identification: *"optical apparatus and instruments, namely, infrared signal transmitters and lasers"*

examining attorney's objection: applicant must specify the type of "lasers," e.g., lasers not for medical use.

6. Current identification: *"teaching apparatus and instruments, namely, laboratory and scientific equipment"*

examining attorney's objection: "laboratory and scientific equipment" is indefinite - applicant must be specific.

7. Current identification: *"computer software, namely, software used for the operation of cellular mobile telecommunication and data communication systems, and database management; computer hardware and peripheral equipment therefor; multimedia software recorded on CD-ROM used for the operation of cellular mobile telecommunication and data communication systems; electronic and magnetic storage media, namely, CD-ROMs, video discs, optical drives, magnetic disc drives, magnetic tapes and optical data carriers"*

examining attorney's objection: applicant must specify whether the "electronic and magnetic storage media" is prerecorded or blank, and, if prerecorded, the nature of the data or information contained thereon.

8. Current identification: *"electronic memory integrated circuit chips; voice coders and decoders; tapes, discs, wires and cards all encoded with computer programs and/or data used for the operation of cellular mobile telecommunication and data communication systems, and database management"*

examining attorney's objection: "and/or" must be replaced with the word "and."

9. Current identification: *"magnetically encoded pre-paid cards, smart cards and SIM (Subscriber identity Module) cards; video conferencing equipment, namely teleconferencing equipment"*

examining attorney's objection: Parenthetical clauses are unacceptable; applicant must delete "SIM" and the parentheses around "Subscriber Identity Module."

10. Current identification: *"optical character recognition apparatus; communications equipment, namely, cellular mobile telephone stations/handsets, radio receivers and transmitters, audio and video broadcasting apparatus namely, digital and analogue signal transmitters, receivers and converters, radio, television and telephone transmitters, receivers and servers; fixed multi-channel communication apparatus"*

examining attorney's objection: "stations/handsets" is unacceptable and should be replaced with "stations and handsets."

11. Current identification: *"modems, vehicular communication apparatus, namely mobile phones, vehicular transceivers, and car kits for the adaptation of portable communication apparatus and instruments for vehicular use"*

examining attorney's objection: "car kits" is indefinite; the components thereof must be identified.

12. Current identification: *"facsimile machines, data communication apparatus, namely transmitters, receivers, transceivers and microprocessors"*

examining attorney's objection: applicant must identify the type of transmitters, e.g., telephone transmitters.

13. Current identification: *"voice frequency transmitters, telephone transmitters and receivers, and telephone terminals for the transmission, storage and reproductions of sound, text, images and data; and parts thereof"*

examining attorney's objection: applicant must identify the type of "voice frequency transmitters", e.g., voice frequency telephone transmitters.

Applicant's only argument in its brief is that its amended identification of goods in its Request for Reconsideration complies with the requirements set forth in the final office action.<sup>4</sup>

We have carefully reviewed both the identification of goods in International Class 9, as it evolved from the originally-filed application to the request for reconsideration, and the examining attorney's specific requirements for amendments to the identification of goods throughout prosecution of the application.

The position taken by the examining attorney, the specific requirements of which are detailed in her brief, are the same as those set forth in her e-mail to applicant's attorney regarding the amended identification of goods in the request for reconsideration, and entirely consistent with the requirement for greater specificity in the final office action. It is entirely reasonable that the specific requirements in the denial of the request for reconsideration would change from those enunciated in the final action to address indefinite language remaining in the amendment contained in the request for reconsideration.

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<sup>4</sup> Applicant does not contend that the final office action or the appeal is premature or that the examining attorney's requirements are substantively or grammatically incorrect or frivolous.



We are perplexed by applicant's action in a case that should have been resolved long prior to its reaching the Board for a decision on appeal. In an application such as this one, involving a long and technical identification of goods in International Class 9, it is mere common sense that applicant and the examining attorney should make every effort to communicate to resolve any problems or miscommunications. From the record it appears that neither applicant's attorney nor the originally-assigned examining attorney made any such attempts. However, following applicant's request for reconsideration, which included an amended identification of goods and services, the newly-assigned examining attorney sent applicant's attorney, via e-mail, a very detailed list of the problems remaining with the identification of goods in International Class 9. She also documented her subsequent attempts to reach applicant's attorney by telephone and e-mail to resolve these problems. She reports in her brief that applicant simply did not respond.

The mere fact that applicant amended its identification of goods in response to the final office action does not automatically render that identification of goods acceptable. Therefore, having considered the

individual requirements made by the examining attorney as the basis for the refusal to register, we make the findings stated below.

The examining attorney has established, by submission of a copy of the registration from the records of the U.S. Patent and Trademark Office (PTO), that Playstation is a registered trademark. Therefore, it may not be used in a descriptive manner to identify a type of product in an identification of goods. The requirement to delete this term is correct.

We agree with the examining attorney's conclusion that the phrases "laboratory and scientific equipment" and "car kits" are overly broad and, thus, indefinite. Even in the context of the full identification of goods, it is not clear what comprises such "equipment" or "kits," or whether the components should be properly listed in other classes if sold separately. The requirement for specification in these two cases is correct.

However, we find that the remaining requirements are unnecessary. When the allegedly indefinite terms are considered in the context of the entire phrase in which they appear or within the entire identification of goods in International Class 9, the language is adequately

specific. In particular, we note that there is no need to preface the terms "network terminals" and "networking infrastructure equipment" with the word "computer" in these specific contexts, because the word "computer" is self-evident from the context. Also, it is not necessary to further specify the nature of "telecommunications transmitters," "data communication transmitters," or "voice frequency transmitters" because their character is clearly understood within the context of the larger identification of goods in that class. Finally, while there are contexts in which "and/or" or the use of a slash "/" may be ambiguous, there is no per se rule in this regard and the context must be considered. In this case, the meanings of these terms and symbols are clear within the context of the highly related subject matter in the identification of goods. Similarly there is no per se rule that parentheses are unacceptable. In this case, there is no ambiguity in the use of parentheses to give the full meaning of an acronym.

Because several aspects of the identification of goods in International Class 9 remain indefinite, the refusal to register on the grounds that the identification of goods in International Class 9 is indefinite is appropriate.

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*Decision:* The refusal under Section 1 of the Act,  
on the ground that the identification of goods in  
International Class 9 is indefinite, is affirmed.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re European Telecommunications Standards Institute

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Serial No. 75/591,159

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**Amendment to Decision**

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Mark B. Harrison of Venable, Baetjer, Howard and Civiletti for European Telecommunications Standards Institute.

Tonja M. Gaskins, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

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Before Hairston, Walters and Drost, Administrative Trademark Judges.

Walters, Administrative Trademark Judge:

The decision issued July 10, 2002, is hereby amended by:

(1) deletion of footnote 2 from the opinion and

substitution of the following as footnote 2:

<sup>2</sup> The application includes services in International Class 39 that are not subject to refusal and, thus, are not considered in this appeal. Should applicant not ultimately prevail in its appeal, the application will be forwarded for publication for the services in International Class 39 only. Applicant may not seek a remand after this Board's decision for consideration of a further amendment to its identification

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of goods in International Class 9, as the Board has no authority to allow such action. Applicant's only recourse would be to file a new application for the goods in International Class 9.

and

(2) addition of the following sentence to the end of the opinion:

The application will be forwarded for publication in International Class 39 for the identified services only.

The time for appeal will run from the date of this

"Amendment to Decision."